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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,793	05/03/2002	Uwe Bunz	CERA-236	7286
24972	7590	04/28/2005	EXAMINER	
FULBRIGHT & JAWORSKI, LLP			RAMANA, ANURADHA	
666 FIFTH AVE			ART UNIT	
NEW YORK, NY 10103-3198			PAPER NUMBER	

3732

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary

Application No.

10/019,793

Applicant(s)

BUNZ ET AL

Examiner

Anu Ramana

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/6/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46-74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 46-74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 56 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim, or amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 57, 60, 64, 66, 68, 72 and 74 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 57, line 1, and claim 64, line 1, "n" lacks antecedent basis.

In claim 60, line 5, it is unclear what Applicant is claiming by "that is remote from an open." Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 60, 66, 68 and 70 are rejected under 35 U.S.C. 102(b) as being anticipated by Gautier (US 5,108,448).

Gautier discloses a sandwich insert having an inner spherical shell or cup 3 made of a ceramic material, an intermediate spherical shell 4 or cover made from

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polyethylene or plastic and an outer spherical shell 2 made of metal wherein the inner cup 3 has a stud 18 (two-sided body in cross section) on the central axis of its outer surface for engagement with cover 4 by a snap-fit connection, by projecting into housing 19 at the vertex or pole of cover 4 (col. 4, lines 34-38; col. 5, lines 10-29; col. 6, lines 17-35; and Figure 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 46-49, 50-59, 61, 63, 64, 65, 67, 69 and 71-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gautier (US 5,108,448).

Gautier discloses all elements of the claimed invention except for a stud having a polygonal shape (3, 4, 5 or 6 sides), an oval shape or a length between 1 to 8 mm. See discussion for claim 60.

Regarding claims 46, 52, 55, 56, 57, 58 and 64, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have made stud 18 with a polygonal shape having 3, 4, 5 or 6 sides or an oval shape since it has been held that mere changes in shape are a matter of obvious design choice absent any persuasive evidence that the particular shape or configuration is significant. *In re Dailey*, 149 USPQ 47 (CCPA 1976).

Regarding claims 47, 54, 59 and 71-74, although Gautier is silent with respect to the length of stud 18, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided a stud having an axial length of 1 to 8 mm or 2 mm, since it has been held that where the general conditions of a claim (stud 18 has a finite length) are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

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Regarding claims 49 and 63, it would have been an obvious matter of design choice to a person of ordinary skill in the art at the time the invention was made to extend the stud through the plastic cover in the Gautier assembly because Applicant has not disclosed that extending the stud completely through the plastic cover provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art would have expected the Gautier assembly and Applicant's invention to perform equally well because both perform the same function of locking cups together.

Claims 46-49, 50-57, 61, 63 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gautier (US 5,108,448) in view of Burrows et al. (US 6,048,365).

Gautier et al. disclose all elements of the claimed invention except for different shapes of stud 18 and a stud length in a range of 1-8 mm.

Burrows et al. teach different cross sections of a pin 530 and a receiving recess 432, such as any non-round polygonal cross section to provide constraint against rotation of two mechanically joined parts, 412 and 510 (col. 4, lines 62-67 and col. 5, lines 1-3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided any non-round polygonal cross section to stud 18 and receiving housing 19 to provide a constraint for rotation between mechanically joined components 4 and 3, as taught by Burrows et al.

Regarding claims 47 and 54, although the combination of Gautier and Burrows et al. is silent with respect to the length of stud 18, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided a stud having an axial length of 1 to 8 mm or 2 mm, since it has been held that where the general conditions of a claim (stud 18 has a finite length) are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claims 49 and 63, it would have been an obvious matter of design choice to a person of ordinary skill in the art at the time the invention was made to

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extend the stud through the plastic cover in the Gautier assembly because Applicant has not disclosed that extending the stud completely through the plastic cover provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art would have expected the assembly of the combination of Gautier and Burrows et al. and Applicant's invention to perform equally well because both perform the same function of locking cups together.

Claims 49 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gautier (US 5,108,448), as applied to claims 46 and 58, in view of Rhenter et al. (US 4,878,916).

Gautier discloses all elements of the claimed invention except for the stud extending completely through the plastic cover.

Rhenter et al. teach two cupules or shells mechanically joined together by a lug or stud extending completely through an outer shell (Fig. 4 and col. 3, lines 19-32).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute a lug as, for example, taught by the Rhenter et al. reference for the stud of the Gautier device wherein so doing would amount to mere substitution of one functionally equivalent structure for another within the same art and the selection of any of these structures would work equally well in the claimed device.

Response to Arguments

Applicant's arguments filed on December 6, 2004 have been fully considered but are not persuasive.

Applicant's arguments with regard to the shape of the stud are not persuasive, since applicants have not provided any convincing showing that the polygonal or oval shape of the stud is anything more than a design choice over a cylindrical stud. Applicants have not provided any showing that such limitations are "critical". *In re Cole*, 140 USPQ 230 (CCPA 1964); *In re Kuhle*, 188 USPQ 7 (CCPA 1975); *In re Davies*, 177 USPQ 381 (CCPA 1973). Mere arguments by counsel cannot take the place of

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evidence. *In re Cole*, 236 F.2d 769, 773, 140 USPQ 230, 233 (CCPA 1964); *In re Walters*, 168 f.2d 79, 80, 77 USPQ 609, 610 (CCPA 1948); et al.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR *Anuradha Ramare*
April 20, 2005

Kevin Shaver
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